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IBM CORPORATION 3039 CORNWALLIS RD. DEPT. T81 / B503, PO BOX 12195 RESEARCH TRIANGLE PARK, NC 27709			ENGLAND, DAVID E	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEFAN GEORG HILD
and SANDEEP K. SINGHAL

Appeal 2008-001895
Application 09/532,937
Technology Center 2800

Decided: October 21, 2009

Before JAMES D. THOMAS, KENNETH W. HAIRSTON,
and JOSEPH L. DIXON, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134 from the final rejection of claim 21.

In a prior appeal (i.e., 2006-3090) of the subject application, the Board issued a Decision, dated February 16, 2007, wherein we affirmed the decision of the Examiner rejecting claim 21 under the first paragraph of 35

U.S.C. § 112, reversed the decision of the Examiner rejecting claims 1, 2, 11, 12, 21, and 22 under 35 U.S.C. § 102(e), and reversed the decision of the Examiner rejecting claims 5 to 10, 15 to 20, 25 to 30, 32, 34, and 36 to 45 under 35 U.S.C. § 103(a). Shortly after issuing the February 16, 2007 Decision, we discovered that the Examiner had mailed an Advisory Action on September 24, 2004 that indicated that the After-Final Amendment made to claim 21 had overcome the rejection of claim 21 under the first paragraph of 35 U.S.C. § 112. In order to clarify the status of claim 21, we issued an Order To Vacate And To Remand, dated April 30, 2007, that specifically stated that “we hereby VACATE only the portion of our February 16, 2007 Decision wherein we affirmed the rejection of claim 21 under the first paragraph of 35 U.S.C. § 112, and REMAND the application to the Examiner to determine whether the written description rejection applies to claim 21.”

Notwithstanding our specific order to the Examiner, the Examiner’s Answer mailed May 18, 2007 includes rejections of additional claims under the first paragraph of 35 U.S.C. § 112¹, and repeats the prior art rejections that were reversed in our February 16, 2007 Decision². In response, Appellants argue (Reply Br. 2 and 3) that by virtue of the Board’s order only the written description rejection of claim 21 remains before the Board, and that “with respect to the only issue remanded to the Examiner, Appellants respectfully request that the section 112 rejection with respect to Claim 21 be reversed for at least the reason that the Examiner indicated in the

¹ It is procedurally improper to introduce a new ground of rejection in an Examiner’s Answer.

² A request for rehearing of our decision was not filed by the Examiner.

Advisory Action of September 24, 2004 that the Section 112 rejection with respect to Claim 21 had been overcome.” We will reverse.

The disclosed invention relates to designating client properties in a networked environment.

Claim 21 is the only claim before us on appeal, and it reads as follows:

21. In a networked environment, a computer program product recorded on computer readable medium for designating client properties comprising:

computer readable means for receiving a link element associated with a server, the link element including a plurality of requested client properties;

computer readable means for selecting said link element to request a document identified by the link element to be transmitted to a client; and

computer readable means for inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties.

The Examiner rejected claim 21 under the first paragraph of 35 U.S.C. § 112 because “there is no support in the original disclosure of the teachings of a plurality of requested client properties being less than all available client properties” (Ans. 4).

Inasmuch as the Amendment After Final dated, August 23, 2004, clearly shows the cancellation of the phrase “the plurality of requested client properties being less than all available client properties,” we must agree with Appellants’ argument *supra* that the Amendment overcame the written

Appeal 2008-001895
Application 09/532,937

description rejection. Thus, the written description rejection of claim 21 is reversed.

The decision of the Examiner is reversed.

REVERSED

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